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| TROJAN LAW OFFICES 9250 WILSHIRE BLVD SUITE 325 BEVERLY HILLS, CA 90212 | | | EXAMINER SUERETH, SARAH ELIZABETH | |
| | | | ART UNIT 3749 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/844,564

Applicant(s)

CHANG, MING YU

Examiner

Sarah Suereth

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 3, 6, 8, 9, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 6, 8, 9, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/09 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the circular discs having the same diameter as the striking wheel must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 2, 8, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **U.S. Patent No. 5,769,625 to Sher** ("Sher").

6. Sher discloses a disposable lighter, comprising:

a lighter body (601) for receiving a liquefied fuel therein;

a mounting frame (614) which is sealedly affixed on top of said lighter body (Figure 1) comprising a first (614b) and a second (614b) supporting wall upwardly extended from two sides of said mounting frame (614),

a gas nozzle (608), a flint spring (617), a gas lever (616), a gas valve (607);

an ignition device comprising a flint (618) and a striking wheel (720), said striking wheel having a circumferential coarse striking surface (722) being positioned right above and in contact with said flint and rotatably mounting between said first and second supporting walls (720A is rotatable mounting), two discs (720) with a glossy surface (col. 4 line 45) and a U-shaped wind shield (621) with the claimed structure (Figure 1).

7. Although Sher Figure 1 shows the wind shield having curved upper edges, it is not completely clear if the radius of the curve equals one fourth of the circumference of the striker wheel.

8. However, this dimension is not critical to the practice of the invention, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sher curved side to have a radius equal to one fourth of the circumference of the striker wheel as a matter of obvious design choice.

9. Sher, as discussed above, discloses the invention as claimed with the exception of showing the discs having a diameter slightly larger than the striker wheel (Figure 5) instead of equal to the striker wheel.

The courts have held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. (In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), also MPEP 2144.04).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sher apparatus by making the striking wheel have a diameter equal to the striking wheel as a matter of obvious design choice.

10. **Claims 3, 6, 9 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **U.S. Patent No. 5,769,625 to Sher** ("Sher") in view of **U.S. Patent No. 2,481,195 to Burchett** ("Burchett").

11. Sher discloses a disposable lighter, comprising:

a lighter body (601) for receiving a liquefied fuel therein;

a mounting frame (614) which is sealedly affixed on top of said lighter body (Figure 1) comprising a first (614b) and a second (614b) supporting wall upwardly extended from two sides of said mounting frame (614),

a gas nozzle (608), a flint spring (617), a gas lever (616), a gas valve (607);

an ignition device comprising a flint (618) and a striking wheel (720), said striking wheel having a circumferential coarse striking surface (722) being positioned right above and in contact with said flint and rotatably mounting between said first and second supporting walls (720A is rotatable mounting), two discs (720) with a glossy surface (col. 4 line 45) and a U-shaped wind shield (621) with the claimed structure (Figure 1).

12. Although Sher Figure 1 shows the wind shield having curved upper edges, it is not completely clear if the radius of the curve equals one fourth of the circumference of the striker wheel.

13. However, this dimension is not critical to the practice of the invention, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sher curved side to have a radius equal to one fourth of the circumference of the striker wheel as a matter of obvious design choice.

14. Sher, as discussed above, discloses the invention as claimed with the exception of showing the discs having a diameter larger than the striker wheel (Figure 5).

15. Burchett discloses a similar lighter, having a striker wheel (5) surrounded by two discs (6) in the same manner as Sher and applicant.

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sher striker wheel to by making the outer discs smaller than the striking wheel as taught by Burchett, in order to use a size of supporting discs than can be produced more inexpensively than the prior art discs (col. 8, lines 5-10).

Reissue Applications

17. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,897,307 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Response to Arguments

18. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Suereth whose telephone number is (571)272-9061. The examiner can normally be reached on Mondays & Tuesdays 8:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven McAllister, can be reached (571) 272-6785. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sarah Suereth/

Examiner, Art Unit 3749

/Steven B. McAllister/

Supervisory Patent Examiner, Art Unit 3749